

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Art Unit : 3637
Applicant : Kirt Martin et al.
Appln. No. : 10/789,597
Filing Date : February 27, 2004
Confirmation No. : 9061
For : **FREESTANDING WORKSTATION**

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION - 37 CFR §41.37)

1. Transmitted herewith is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on April 19, 2007.

2. **STATUS OF APPLICANTS**

This application is on behalf of other than a small entity.

3. **FEE FOR FILING APPEAL BRIEF**

Pursuant to 35 USC §41(a)(6), the fee for filing the Appeal Brief is other than a small entity (\$500.00).

4. **EXTENSION OF TERM**

The proceedings herein are for a patent application and the provisions of 35 USC §41(a)(8) apply.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. **TOTAL FEE DUE**

The total fee due is \$500 (Appeal Brief fee).

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6. FEE PAYMENT

Charge Account No. 16 2463 the sum of \$500.00.

7. FEE DEFICIENCY

 x If any additional extension and/or fee is required, this is a request therefor
and to charge Account No. 16 2463.

and/or

 x If any additional fee for claims is required, charge Account No.
16 2463.

Respectfully submitted,

Dated: July 19, 2007

 /Brian E. Ainsworth/

Brian E. Ainsworth, Registration No. 45 808
Price, Heneveld, Cooper, DeWitt & Litton, LLP
695 Kenmoor, S.E.
Post Office Box 2567
Grand Rapids, Michigan 49501
(616) 949-9610

BEA:kjc

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APPEAL BRIEF (37 CFR §41.37)

This brief is in furtherance of the Notice of Appeal filed in this case on April 19, 2007.

The fees required under 35 USC 41(a)(6), and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. §41.37(c)):

- I. Real Party in Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of the Claimed Subject Matter
- VI. Grounds of Rejection to Be Reviewed on Appeal
- VII. Argument
- VIII. Claims Appendix (Attached as Appendix A)
- IX. Evidence Appendix (Attached as Appendix B)
- X. Related Proceedings Appendix (Attached as Appendix C)

The final page of this brief bears the attorney's signature.

I. Real Party in Interest

The real party in interest in this application is Steelcase Development Corporation, the assignment to which was recorded at Reel 15039, Frame 0270 on February 27, 2004.

II. Related Appeals and Interferences

There are no other appeals or interferences known to Applicant, the Applicant's local representative, or Assignee which will directly affect or be directly affected by or have a bearing on the Board's decision and pending appeal.

III. Status of Claims

This is an appeal to the Board of Patent Appeals and Interferences from the decision of Primary Examiner dated January 19, 2007, finally rejecting claims 1-19, which are pending in the above-identified patent application. Claims 20-63 stand withdrawn. Claims 1-19 have been finally rejected and are appealed.

Claims 1-63 were presented in the application as filed.

Pursuant to 37 C.F.R. §1.111, an election of claim 1-19 was made with traverse.

In a first Office Action on the merits, claims 20-63 were withdrawn.

Pursuant to 37 C.F.R. §1.111, in response to the first Office Action on the merits, claims 3, 6, 9, 10, 14, 17 and 18 were amended.

Pursuant to 37 C.F.R. §1.111, in response to the second Office Action on the merits, claims 5, 10, 16 and 18 were amended.

A copy of the claims on appeal is attached as Appendix A.

IV. Status of Amendments

All amendments requested by Applicants have been entered into the record, and there are no currently pending amendments to the application.

V. Summary of the Claimed Subject Matter

Claim 1 defines an aspect of the present invention as providing a privacy screen 26, for use within a desk assembly 12 having a worksurface 22 and an open span located below the worksurface 22 that comprises a first member 54 having a generally planar first portion 58, a first flange 60 extending longitudinally along the first planar portion 58, and a first end 70 adapted to be secured to a desk assembly 12 within an open span located below a worksurface 22 of the desk assembly 12. Claim 1 further defines a second member 56 have a generally planar second portion 74, a second

flange 76 extending longitudinally along the second planar portion 74 and configured to telescopingly receive the first flange 60 of the first member 54 therein such that planar second portion 74 is substantially proximate the planar first portion 58, and a second end 80 adapted to be secured to the desk assembly 12 within the span located below the worksurface 22 of the desk assembly 12, wherein the first member 54 and second member 56 are telescopingly adjustable with respect to one another, thereby allowing adjustment of an overall length of the privacy screen 26 extending between the first end 70 and the second end 80. Claim 1 is described in the specification in paragraphs 29 and 31-33 and illustrated in Figs. 1, 2 and 4-6.

Claim 12 defines another aspect of the present invention as providing a desk assembly 12 that comprises a worksurface 22, a first supporting member 16 supporting a worksurface 22, and a second supporting member 20 supporting the worksurface 16, wherein the first supporting member 16 and the second supporting member 20 cooperate to define a span therebetween. Claims 12 further defines the desk assembly 12 as comprising a privacy screen assembly 26 that comprises a first member 54 having a generally planar first portion 58, a first flange 60 extending longitudinally along the planar first portion 58, and a first end 70 adapted to be secured to the first supporting member 16, and a second member 56 have a generally planar second portion 74, a second flange 76 extending longitudinally along the planar second portion 74 and telescopingly received within the first flange 60 of the first member 54, such that planar second portion 74 is substantially proximate the planar first portion 58, and a second end 80 secured to the second supporting member 20, such that the first member 54 and second member 56 are telescopingly adjusted with respect to one another to extend across an entire length of the span. Claim 12 is described in the specification in paragraphs 29 and 30-33, and illustrated in Figs. 1, 2 and 4-6.

VI. Grounds of Rejection to Be Reviewed on Appeal

The Examiner finally rejected claims 1-19 under 35 U.S.C. §103 as being unpatentable over Bayles, U.S. Patent No. 4,287,837 in view of Long, U.S. Patent No. 3,000,681, in further view of Diamond et al., U.S. Patent No. 3,698,329.

VII. Argument

Applicants contend that the numerous references as combined by the Examiner fail to render obvious that which is defined in each of independent claims 1 and 12. Claim 1 defines a privacy screen for use within a desk assembly having a worksurface and an open span located above the worksurface that comprises, among other things, a first member and a second member each having a generally planar first portion, a flange extending longitudinally along the first planar portion, and an end adapted to be secured to a desk assembly within the open span, wherein the flange of the second member telescopically receives the flange of the first member, and wherein the first member and the second member are telescopically adjustable with respect to one another, thereby allowing adjustment of an overall length of the privacy screen extending between first and second ends thereof. The Bayles, Long and Diamond et al. references as cited fail to teach, motivate, or suggest that which is defined in claim 1.

It is well established law that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d. 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Further, the mere fact that prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). Still further, the proper test for evaluating prior art under 35 U.S.C. §103 is whether or not the prior art, either individually or taken together, can be seen as suggesting the Applicant's solution to the problem which the invention addresses. *Rosemont, Inc. v. Beckman Industries, Inc.*, 732 F.2d. 1540, 1546, 221, U.S.P.Q. 1, 7 (Fed. Cir. 1984). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references or the combination in the manner claimed. *In re Rouffet*, 42 U.S.P.Q.2d 1453,1458 (Fed. Cir. 1998). Moreover, to imbue one of ordinary skill in the art with the knowledge of the invention, where no

prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (citing *W.L. Gore and Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-313 (Fed. Cir. 1983)). Finally, the Supreme Court recently affirmed that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex, Inc., et al.*, 127 S.Ct. 1727, 1731 (2007).

The Examiner states that while Bayles teaches a privacy screen, it does not teach a telescopingly adjusting second portion of the privacy screen, and then cites Long as teaching a telescoping privacy screen (22 and 22a). However, Long discloses “two laterally slidable telescoping parts 22 and 22a that are essentially the same shape and comprise respectively vertical rear walls 23 and 23a, vertical side walls 24 and 24a..., and forwardly upwardly inclined walls 25 and 25a.” See Long, column 1, lines 49-54. The purpose of this configuration is clearly described in column 1, lines 7-23 of the Long reference and, in short, includes providing an expandable waste basket. No where does Long teach, motivate or suggest that the purpose behind that which is disclosed is to provide privacy. Moreover, selecting only certain portions of the waste basket as disclosed by Long requires an impermissible picking-and-choosing of certain elements thereof, including selecting certain portions of integrally formed components. In essence, it appears that the combination of Bayles and Long is based on the argument that it would have been obvious to combine a trash can with a privacy screen regardless of the specifics of the trash can. Further, the Examiner then states that “Bayles, as modified [by Long] does not teach details of the telescoping adjusting second portion of the privacy screen and cites Diamond et al. as providing that which is lacking.” However, Diamond et al. teaches a horizontally-positioned wall mounted shelf assembly for use within a closet. The Applicant contends that no person of ordinary skill in the art would have sought to combine the teachings of a shelf system for use within a permanent closet structure with a knock-down desk as disclosed by Bayles and/or a waste receptacle as disclosed by Long. Further, Applicant can find no teaching, motivation or suggestion within any of the art as cited by the Examiner for the

idea of utilizing a closet shelf for a privacy barrier. To summarize, it appears that the overall rejection is based on the argument that it would have been obvious to one of ordinary skill in the art to modify the solid state modesty panel of Bayles by combining it with the telescoping trash can of Long, including the picking-and-choosing of certain components therefrom, and in turn combining that combination with the closet shelf of Diamond et al. The only motivation the Applicant can find for providing an adjustable length privacy panel within a desk and including the flanges as defined is located within the Applicant's own application. As noted above, such hindsight construction is improper. Therefore, claim 1 cannot be rendered obvious by that which is disclosed in Bayles in combination with Long, in further combination with Diamond et al.

Applicants submit that the rejected claims 1-19 are allowable under 35 U.S.C. §§103. Specifically, Applicants submit that the rejected claims are patentable over the references of Bayles, in view of Long, in further view of Diamond et al. More specifically, Applicants contend that a person of ordinary skill in the art would not have found it obvious to combine the solid state modesty panel of Bayles with the waste receptacle of Long, and further with the closet shelf of Diamond et al., and that such a combination is not taught, motivated or suggested in any of the references as cited and would have been motivated by the knowledge of a person with ordinary skill in the art, and that such a combination would require the picking-and-choosing of certain elements from the cited references while using the inventors own disclosure as a template to make such a combination. Applicants believe that the currently pending claims are in condition for allowance, and a Notice of Allowability indicating the same is earnestly solicited.

Respectfully submitted,

By: Price, Heneveld, Cooper,
DeWitt & Litton, LLP

Dated: July 19, 2007

/Brian E. Ainsworth/

Brian E. Ainsworth
Registration No. 45 808
695 Kenmoor, S.E.
Post Office Box 2567
Grand Rapids, Michigan 49501
(616) 949-9610

BEA:kjc

VII. APPENDIX A - CLAIMS ON APPEAL

1. A privacy screen for use within a desk assembly having a worksurface and an open span located below the worksurface, comprising:

a first member having a generally planar first portion, a first flange extending longitudinally along the first planar portion, and a first end adapted to be secured to a desk assembly within an open span located below a worksurface of the desk assembly; and

a second member have a generally planar second portion, a second flange extending longitudinally along the second planar portion and configured to telescopingly receive the first flange of the first member therein such that planar second portion is substantially proximate the planar first portion, and a second end adapted to be secured to the desk assembly within the span located below the worksurface of the desk assembly;

wherein the first member and second member is telescopingly adjustable with respect to one another, thereby allowing adjustment of an overall length of the privacy screen extending between the first end and the second end.

2. The privacy screen of claim 1, wherein the first flange is substantially C-shaped.

3. The privacy screen of claim 2, wherein the second flange includes a first portion extending from and substantially orthogonal to the planar second portion of the second member, a second portion extending from and substantially orthogonal to the first portion of the second flange, and a lip portion extending from the second portion of the second flange and towards the planar second portion of the second member.

4. The privacy screen of claim 3, wherein the second flange is substantially C-shaped.

5. The privacy screen of claim 4, wherein the first flange includes a first portion extending from and substantially orthogonal to the planar portion of the first member, and a second portion extending from and substantially orthogonal to the first portion of

the first flange, and wherein the second portion of the first flange is telescopingly received between the second portion of the second flange and the lip portion of the second flange.

6. The privacy screen of claim 4, wherein the first member further includes an upper flange extending longitudinally along the first planar portion, the second member further includes an upper flange extending longitudinally along the second planar portion, and wherein the upper flange of the first member and the upper flange of the second member are substantially proximate to one another when the first member and the second member are telescopingly assembled.

7. The privacy screen of claim 6, wherein at least a select one of the first upper flange and the second upper flange includes at least one aperture extending therethrough that is adapted to receive a fastener for securing the privacy screen to the worksurface.

8. The privacy screen of claim 6, wherein at least a selected one of the first end and the second end includes an end flange that includes at least one aperture extending therethrough that is adapted to receive a fastener for securing the privacy screen to the desk assembly.

9. The privacy screen of claim 1, wherein the first member further includes an upper flange extending longitudinally along the first planar portion, the second member further includes an upper flange extending longitudinally along the second planar portion, and wherein the upper flange of the first member and the upper flange of the second member are substantially proximate to one another when the first member and the second member are telescopingly assembled.

10. The privacy screen of claim 1, wherein the first member includes an upper flange extending longitudinally along the first planar portion, the second member includes an upper flange extending longitudinally along the second planar portion, and wherein at

least a select one of the upper flange of the first member and the upper flange of the second member includes at least one aperture extending there through that is adapted to receive a fastener for securing the privacy screen to the worksurface.

11. The privacy screen of claim 1, wherein at least a selected one of the first end and the second end includes an end flange that includes at least one aperture extending there through that is adapted to receive a fastener for securing the privacy screen to the desk assembly.

12. A desk assembly, comprising:

- a worksurface;

- a first supporting member supporting the worksurface;

- a second supporting member supporting the worksurface, wherein the first supporting member and the second supporting member cooperate to define a span therebetween; and

- a privacy screen assembly, comprising:

 - a first member having a generally planar first portion, a first flange extending longitudinally along the planar first portion, and a first end adapted to be secured to the first supporting member; and

 - a second member have a generally planar second portion, a second flange extending longitudinally along the planar second portion and telescopingly received within the first flange of the first member, such that planar second portion is substantially proximate the planar first portion, and a second end secured to the second supporting member, such that the first member and second member are telescopingly adjusted with respect to one another to extend across an entire length of the span.

13. The desk assembly of claim 12, wherein the first flange of the first member is substantially C-shaped.

14. The desk assembly of claim 13, wherein the second flange of the second member includes a first portion extending from and substantially orthogonal to the planar second portion of the second member, a second portion extending from and substantially orthogonal to the first portion of the second flange, and a lip portion extending from the second portion of the second member and towards the planar second portion of the second member.

15. The desk assembly of claim 14, wherein the second flange of the second member is substantially C-shaped.

16. The desk assembly of claim 15, wherein the first flange of the first member includes a first portion extending from and substantially orthogonal to the planar portion of the first member, and a second portion extending from and substantially orthogonal to the first portion of the first flange, and wherein the second portion of the first flange is telescopingly received between the second portion and the lip portion of the second flange.

17. The desk assembly of claim 12, wherein the first member of the privacy screen further includes an upper flange extending longitudinally along the first planar portion, the second member of the privacy screen further includes an upper flange extending longitudinally along the second planar portion, and wherein the upper flange of the first member and upper flange of the second member are substantially proximate to one another when the first member and the second member are telescopingly assembled.

18. The desk assembly of claim 12, wherein the first member includes an upper flange extending longitudinally along the first planar portion, the second member includes an upper flange extending longitudinally along the second planar portion, and wherein at least a select one of the upper flange of the first member and the upper flange of the second member includes at least one aperture extending there through that receives a fastener there through, thereby securing the privacy screen to the worksurface.

19. The desk assembly of claim 12, wherein at least a selected one of the first end and the second end includes an end flange that includes at least one aperture extending there through that receives a fastener there through, thereby securing the privacy screen to at least a selected one of the first support member and the second support member.

IX. APPENDIX B: 37 EVIDENCE SUBMITTED UNDER C.F.R. §41.37(c)(1)(9)

No evidence was submitted under 37 C.F.R. §1.130, 1.131 or 1.132.

X. APPENDIX C: PRIOR RELATED PROCEEDINGS UNDER 37 C.F.R.
§41.37(c)(1)(10)

No related proceedings